

**TAIWAN** 

## United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

ATTORNEY DOCKET NO. APPLICATION NO. FILING DATE FIRST NAMED INVENTOR CONFIRMATION NO. 10/604,393 07/17/2003 Li-Hsien Yen 10026-US-PA 1392 04/26/2004 **EXAMINER** 31561 7590 JIANQ CHYUN INTELLECTUAL PROPERTY OFFICE LAM, CATHY FONG FONG 7 FLOOR-1, NO. 100 **ART UNIT** PAPER NUMBER ROOSEVELT ROAD, SECTION 2 TAIPEI, 100 1775

DATE MAILED: 04/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
	10/604,393	YEH ET AL.
Office Action Summary	Examiner	Art Unit
	Cathy Lam	1775
The MAILING DATE of this communication riod for Reply	on appears on the cover sheet w	vith the correspondence address
A SHORTENED STATUTORY PERIOD FOR ITHE MAILING DATE OF THIS COMMUNICAT  - Extensions of time may be available under the provisions of 37 after SIX (6) MONTHS from the mailing date of this communicated. If the period for reply specified above is less than thirty (30) dayself NO period for reply is specified above, the maximum statutory. Failure to reply within the set or extended period for reply will, be Any reply received by the Office later than three months after the earned patent term adjustment. See 37 CFR 1.704(b).	TION.  CFR 1.136(a). In no event, however, may a tion.  s, a reply within the statutory minimum of this period will apply and will expire SIX (6) MOI y statute, cause the application to become A	reply be timely filed  rty (30) days will be considered timely.  NTHS from the mailing date of this communication.  BANDONED (35 U.S.C. § 133).
atus		
1) Responsive to communication(s) filed or	1	
2a)☐ This action is <b>FINAL</b> . 2b)☐	This action is non-final.	•
3) Since this application is in condition for a	·	
closed in accordance with the practice u	nder <i>Ex parte Quayl</i> e, 1935 C.I	D. 11, 453 O.G. 213.
sposition of Claims		
<ul> <li>4) Claim(s) 1-29 is/are pending in the application 4a) Of the above claim(s) is/are w</li> <li>5) Claim(s) is/are allowed.</li> <li>6) Claim(s) is/are rejected.</li> <li>7) Claim(s) is/are objected to.</li> </ul>		
8) Claim(s) are subject to restriction	and/or election requirement.	
plication Papers	·	
9) The specification is objected to by the Ex	aminer.	·
10) The drawing(s) filed on is/are: a)	accepted or b) objected to	by the Examiner.
Applicant may not request that any objection		
Replacement drawing sheet(s) including the	·	
11) The oath or declaration is objected to by	the Examiner. Note the attache	ed Office Action or form PTO-152.
iority under 35 U.S.C. § 119		
12) ☐ Acknowledgment is made of a claim for f a) ☐ All b) ☐ Some * c) ☐ None of:	oreign priority under 35 U.S.C.	§ 119(a)-(d) or (f).
1. Certified copies of the priority doc	uments have been received.	•
2. Certified copies of the priority doc		· ·
3. Copies of the certified copies of the	•	n received in this National Stage
application from the International    * See the attached detailed Office action for	, , , ,	t racaivad
* See the attached detailed Office action for	i a iist of the certified copies no	LICUCIVEU.
	_	

4) Interview Summary (PTO-413)

6) Other: \_\_\_\_\_.

Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

## Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

Priority under 35 U.S.C. § 119

**Disposition of Claims** 

**Application Papers** 

**Period for Reply** 

**Status** 

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date \_\_\_\_\_.

U.S. Patent and Trademark Office

Application/Control Number: 10/604,393

Art Unit: 1775

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- Claims 1-10, drawn to an anti-electromagnetic laminate, classified in class 174, subclass 35MS.
- II. Claims 11-16 and 26-29, drawn to a method of making an antielectromagnetic laminate, classified in class 427, subclass 294.
- III. Claims 17-25, drawn to an anti-electromagnetic wave device, classified in class 361, subclass 139.

The inventions are distinct, each from the other because of the following reasons:

- 2. Inventions I and III are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as a circuit board and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.
- 3. Inventions II and I, III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the

Application/Control Number: 10/604,393

**Art Unit: 1775** 

process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by a different process such as electroless plating the films together. The process as claimed can be used to make a different product such as a multilayer printed circuit board.

- 4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
- 5. An attempt telephone call was made to Atty: Belinda Lee on April 21, 2004 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cathy Lam whose telephone number is (571) 272-1538. The examiner can normally be reached on 9am-6pm.

Application/Control Number: 10/604,393

Art Unit: 1775

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on (571) 272-1535. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Cathy Lam

Primary Examiner

Art Unit 1775

cfl April 22, 2004